Strang, Jonathan (DC)

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Sent: Friday, April 7, 2023 8:32 PM
To: Trials
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Subject: IPR2021-01413; IPR2022-00031; IPR2022-00222 (USP 10,621,228)

Your Honors,

Pursuant to the Board's direction on the March 31, 2023 conference call, the parties submit this joint email.

The parties to all three IPRs agree in principle that a Protective Order with sufficient attorneys' eyes only ("AEO") protections would provide sufficient protection for Unified Patents, LLC's ("Unified's") confidential information. Apple and Samsung desire "inspection" of the confidential record in Unified's IPR by Apple and Samsung counsel. That said, the parties do not agree that the Board's rules allow counsel of non-parties, Apple and Samsung, to "inspect" the confidential record in Unified's IPR.

Notably, the parties to all three IPRs (IPR2021-01413, IPR2022-00031, and IPR2022-00222) agree that this entire exercise would be moot if the Board were to grant the rehearing requested by Unified and vacate the order concerning real parties in interest in the Unified IPR. (MemoryWeb, of course, does not agree that the Board should grant the rehearing request; MemoryWeb further does not agree that the Board should vacate the order.)

The parties respectfully request a follow-up conference with the Board to discuss the conduct of each of the proceedings once the Board has considered the information provided by this communication.

MemoryWeb's Position

Subject to authorization from the Board, MemoryWeb is prepared to proceed with its contemplated motions to terminate in the Apple and Samsung proceedings (IPR2022-00031 and IPR2022-00222), as the Board has already decided that Apple and Samsung are RPIs to the Unified IPR. MemoryWeb understands Apple and Samsung are requesting access to confidential materials from the Unified IPR prior to any briefing but takes no position on the disputes between Unified and Apple and Samsung regarding confidentiality.

MemoryWeb disagrees with Apple and Samsung's contention that the alleged waiver issue should be considered prior to MemoryWeb's motions to terminate. To the extent Apple and/or Samsung wish to argue waiver, MemoryWeb proposes that they do so in their oppositions to MemoryWeb's motions to terminate.

In light of the unique circumstances and lack of precedent addressing these procedural issues, MemoryWeb agrees that good cause exists for extending the one-year statutory deadlines in the Apple and Samsung proceedings.

MemoryWeb received Samsung's position and believes it inappropriately advances substantive arguments that go beyond the scope of the Board's request. Nevertheless, MemoryWeb endeavors to respond and reserves the right to address Samsung's arguments more fully in an appropriate procedural context.

First, Samsung argues that MemoryWeb must prove a negative – no waiver – prior to receiving authorization to file its motion to terminate. There was no waiver and there is no requirement that MemoryWeb disprove Samsung's (or Apple's) waiver defense prior to receiving authorization for its motions. As stated above, Samsung and Apple may raise waiver in their oppositions if they so choose. And contrary to Samsung's assertion below, MemoryWeb *did* advance argument on the RPI/estoppel issues in the Samsung proceeding. *See, e.g.*, POR at 64-66; POSR at 33.

Second, Samsung also argues that MemoryWeb must submit evidence in the Samsung proceeding that Samsung is an RPI to the Unified IPR. MemoryWeb disagrees: the Board properly resolved the RPI issue in the Unified IPR. Alternatively, in the event the Board determines (1) evidence of Samsung/Apple's RPI status must be entered in the Samsung/Apple proceeding and (2) a discovery order is necessary to obtain that information, MemoryWeb requests leave to take that discovery.

Apple's Position

Apple believes that due process demands that it be informed of the basis of the Board's determination that it is a real-party-in-interest of Unified in the Unified proceeding (IPR2021-01413). To gain that understanding, Apple believes it would be appropriate to permit it's outside counsel to inspect the record in the Unified IPR proceeding that bears on the RPI issue, including both evidence and papers. Apple further believes that this inspection of the record by outside counsel should occur immediately to enable Apple to determine how best to protect its interests in IPR2022-00031 and other matters.

Apple believes the Board has the authority to permit outside counsel for Apple to inspect the record of evidence and the papers within the Unified IPR proceeding under 35 U.S.C. 315(d), as all three proceedings concern the same patent. Apple further believes the Board has the authority under § 315(d) and under 37 C.F.R. § 42.5 to "determine a proper course of conduct in a proceeding for any situation not specifically covered" and "may waive or suspend a requirement of parts 1, 41, and 42 and may place conditions on the waiver or suspension." Apple opposes additional discovery in IPR2022-00031 on the RPI issue, as it is untimely and has been waived by MemoryWeb.

Apple believes the RPI issue raised in IPR2021-01413 and the RPI issue MemoryWeb is attempting to belatedly raise in IPR2022-00031 would both be rendered moot if the Board were to grant the rehearing requested by Unified and vacate the order concerning real parties in interest in the Unified IPR. Apple also believes the most efficient and non-prejudicial path to all of the parties at this stage of their respective proceedings would be for the Board to defer a decision on further proceedings in IPR2022-00031 until a decision is rendered on the rehearing request filed by Unified.

To be clear, Apple does not believe MemoryWeb is allowed to raise an RPI issue at this point in its proceeding because it has waived the right to do so. If the RPI decision in the Unified IPR proceeding is not vacated, Apple submits that the Board must take up the issue of waiver as a threshold issue before entertaining any additional proceedings or briefing on RPI and estoppel.

In view of the complexity of this situation, Apple is not opposed to the Board finding that IPR2022-00031 is an exceptional case that would warrant deferral of the final written decision for a period up to six months.

Samsung's Position

Samsung believes that "inspection" of the record of the Unified IPR proceeding is necessary to allow Samsung to make informed decisions on the issues raised by MemoryWeb's request to move to terminate Samsung's IPR. In addition to AEO inspection of the entirety of the papers and evidence in the Unified IPR proceeding, Samsung requests "inspection" by Samsung's in-house counsel of versions of the papers and evidence in the Unified IPR proceeding that redact confidential information specific to Apple. Samsung believes that Unified should be able to appropriately redact the papers and evidence to limit the inspection by Samsung's in-house counsel to only confidential information that is appropriate for Samsung's review.

In terms of what additional process would be necessary in Samsung's IPR if the Board deems additional process to be warranted, Samsung below attempts to offer insight to aid in the Board's consideration of the RPI/estoppel issue.

However, Samsung believes that "inspection" of the record of the Unified IPR proceeding is here again necessary to allow Samsung to offer fully informed thoughts on the extent (e.g., scope, timing, cadence) of process needed to ensure that Samsung is provided a full and fair opportunity to address implicated issues.

Samsung believes that, to establish estoppel of Samsung's challenge to claims 1-7 in Samsung's IPR of the '228 patent, MemoryWeb has the burden of demonstrating, with arguments and supporting evidence in Samsung's IPR, the following facts: (1) that the Unified IPR resulted in a final written decision under section 318(a), (2) that Samsung was a real party in interest or privy of Unified in the Unified IPR, and (3) that Unified raised or reasonably could have raised the grounds pursued in Samsung's IPR. The record in Samsung's IPR does not have any evidence to support a factual determination of any of these three requirements.

Further, because Samsung was not a party to Unified's IPR (IPR2021-01413), Samsung cannot be bound by decisions rendered in that proceeding. Indeed, before estoppel is applied in any way that limits Samsung's rights, Samsung must have an opportunity to confront all allegations and evidence bearing on the above three requirements. Because MemoryWeb has not advanced within the Samsung IPR proceeding record arguments and evidence on these three requirements, if rehearing concludes with the RPI determination in Unified's IPR (IPR2021-01413) intact and if the Board does not find waiver of MemoryWeb's RPI/estoppel arguments, it is Samsung's position that any subsequent process must begin with MemoryWeb demonstrating, consistent with rules governing motion practice that apply to issues not subject to waiver, why MemoryWeb, as the moving party, is entitled to the relief sought in its motion and why MemoryWeb is entitled to submit new evidence into the Samsung IPR record if seeking to use the same to support its motion.

To the extent that the Board allows MemoryWeb to submit its requested motion and to submit new evidence in support of its requested motion, it is necessary to allow Samsung to address the evidence relied upon by MemoryWeb and to allow Samsung the opportunity to furnish additional evidence both to impeach MemoryWeb evidence and to otherwise inform the record. In this regard, the procedures of a typical PTAB trial are, at a minimum, needed to assess any further consideration of MemoryWeb's estoppel arguments and evidence in Samsung's IPR.

Unified's Position

Unified agrees that its confidential information may be sufficiently protected via amended AEO protections, but only if it is produced to parties in a relevant proceeding, e.g., after consolidation or pursuant to a valid third-party subpoena.

Apple and Samsung propose an unprecedented third-party "inspection" of protected materials in the Unified IPR. That is not permissible for two reasons. *First*, the Trial Practice Guide does not provide for third-party access to protected materials. Trial Practice Guide 107-116 (granting access only to parties, their representatives, and the Office).

Second, making documents available for inspection *is* discovery. *See*, *e.g.*, FRCP 34 (document production). There is no mechanism for non-parties to take discovery. Calling discovery by another name does not change that fact, and permitting inspection would threaten the fundamental safeguards inherent in the Board's discovery rules.

Waiting for the POP decision may moot the entire issue, and it also provides the best path to consolidation. If the POP declines review, the panel will regain authority over the proceeding and proceed to the rehearing request. *See* SOP 2 at 7-8. The Board will then have an opportunity to consolidate because rehearing tolls the time for appeal (37 C.F.R. § 90.3), and Apple does not object to extending its one-year deadline.

Very Respectfully,

Daniel Schwartz, counsel for MemoryWeb

Jeffery Kushan, counsel for Apple

Karl Renner, counsel for Samsung

Jonathan Strang, counsel for Unified